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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,186	04/07/2004	Thomas R. Marsh	9066-23DV	7421

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EXAMINER

LUGO, CARLOS

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/820,186	Applicant(s) MARSH ET AL.	
	Examiner Carlos Lugo	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>attachments 1 and 2</u> . |

4.

DETAILED ACTION

1. This Office Action is in response to applicant's RCE filed on November 7, 2005.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
 - The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
3. **Claim 5 is rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites that the projection has a convex portion extending outwardly from the second face of the base member and a planar portion opposite the convex portion, and that the planar portion of the projection has a thickness that is less than the thickness of the base member.

However, as seen in Figure 1, the thickness between the planar and the convex portion of the projection is the same as the thickness of the base member. The only different in thickness is between the thickness of the base member and the planar portion of the base member across the void or the thickness between the planar and the convex portion of the projection and the planar portion of the base member across the void (see attachment #1).

Therefore, in order to continue with the examination, the limitation will be examined as the planar portion of the base member across the void has a thickness that is less than the thickness of the base member. Appropriate correction and/or explanation is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1,4,6-8,10, and 13 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 3,952,455 to McAlarney (McAlarney '455).

Regarding claims 1 and 13, McAlarney '455 discloses a device comprising a base member (20) having opposite first and second faces and a cushioning projection extending outwardly from the second face of the base member and covering and defining a void (26-29) within the base member. The base member has a planar portion extending away from the cushioning projection on opposite sides of the projection. A clip (23 and 25) is connected to the base member. The device is formed as a unitary member and is entirely formed of a polymeric material (Col. 3 Lines 42-62).

As to claim 4, McAlarney '455 illustrates that the projection has a convex portion extending outwardly from the second face of the base member and the base member has a planar portion opposite the convex portion across from the void.

As to claim 6, McAlarney '455 illustrates that the convex portion of the projection has a thickness that is less than the thickness of the base member.

As to claim 7, McAlarney '455 illustrates that the cushioning projection is elongated in a direction generally perpendicular to the thickness of the base member.

As to claim 8, McAlarney '455 illustrates that the cushioning projection is generally semi-circular.

As to claim 10, McAlarney '455 illustrates that the cushioning projection is closed at both ends.

6. **Claims 1,7,10, and 13 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 6,148,584 to Wilson.

As to claims 1 and 13, Wilson discloses a device (150) comprising a base member (152) having opposite first and second faces and a cushioning projection (154) extending outwardly from the second face of the base member and covering and defining a void within the base member. The base member has a planar portion extending away from the cushioning projection on opposite sides of the projection. A clip (163) is connected to the base member. The device is formed as a unitary member and entirely form of a polymeric material.

As to claim 7, Wilson illustrates that the cushioning projection is elongated in a direction generally perpendicular to the thickness of the base member.

As to claim 10, Wilson illustrates that the cushioning projection is closed at both ends.

7. **Claim 5 is rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 2,858,583 to McEvoy et al (McEvoy).

McEvoy discloses a device comprising a base member (27 and 28) having opposite first and second faces and a cushioning projection (25) extending outwardly from the second face of the base member and covering and defining a void within the

base member. The projection has a planar portion opposite the convex portion and the base member has a planar portion opposite the convex portion across the void (see attachment #2). The planar portion of the base member across the void has a thickness less than the thickness of the base member.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1,4,6-9, and 11 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 2,161,648 to Widman in view of US Pat No 1,998,791 to Schanz.

Regarding claim 1, Widman discloses a device comprising a base member (31) having opposite first and second faces and a cushioning projection (32) extending outwardly from the second face of the base member and covering and defining a void (between 31 and 32) within the base member. A clip (34) is connected to the base member. The device is formed as a unitary member.

However, Widman fails to disclose that the device is entirely formed of a polymeric material. Widman discloses that the base member and the cushioning projection are made of a polymeric material both the clip member is made of metal.

Schanz teaches that it is well known in the art to have a base member having a cushioning projection (14) and a clip (15) as a unitary member and entirely formed of a polymeric material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the device described by Widman entirely of one material, polymeric material, in order to reduce costs and manufacturing processes.

As to claim 4, Widman illustrates that the projection has a convex portion extending outwardly from the second face of the base member and the base member has a planar portion opposite the convex portion across from the void.

As to claim 6, Widman illustrates that the convex portion of the projection has a thickness that is less than the thickness of the base member.

As to claim 7, Widman illustrates that the cushioning projection is elongated in a direction generally perpendicular to the thickness of the base member.

As to claim 8, Widman illustrates that the cushioning projection is generally semi-circular.

As to claim 9, Widman illustrates that the cushioning projection as an opening at one end.

As to claim 11, Widman illustrates that the cushioning projection is capable of having a thickness of between about .020 and about .090 inches.

Therefore, it would have being obvious to one having ordinary skill in the art at the time the invention was made to provide the cushioning projection described by Widman with a thickness of between about .020 and about .090 inches since the change in the dimension of a prior art device is a design consideration within the skill of the art. Furthermore, the current specification fails to shows or demonstrates any showing of criticality having this dimension as the thickness of the cushioning portion.

10. Claims 1,4,6-8,10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 2,185,161 to Tinnerman in view of US Pat No 1,998,791 to Schanz.

Regarding claim 1, Tinnerman discloses a device (C) comprising a base member having opposite first and second faces and a cushioning projection (Figures 1 and 2) extending outwardly from the second face of the base member and covering and defining a void within the base member. The device is formed as a unitary member and entirely form of a polymeric material.

However, Tinnerman fails to disclose that the device further comprises a clip connected to the base member. Tinnerman discloses that the base member is attached by other means.

Schanz teaches that it is well known in the art to have a base member having a cushioning projection (14) and a clip (15) to attach the device to a surface. The device is formed as a unitary member and entirely formed of a polymeric material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device described by Tinnerman with a clip, as taught by Schanz, in order to attach the device to a surface with a simple and easy to install structure.

As to claim 4, Tinnerman illustrates that the projection has a convex portion extending outwardly from the second face of the base member and the base member has a planar portion opposite the convex portion across from the void (when the convex portion is compressed).

As to claim 6, Tinnerman illustrates that the convex portion of the projection has a thickness that is less than the thickness of the base member.

As to claim 7, Tinnerman illustrates that the cushioning projection is elongated in a direction generally perpendicular to the thickness of the base member.

As to claim 8, Tinnerman illustrates that the cushioning projection is generally semi-circular.

As to claim 10, Tinnerman illustrates that the cushioning projection is closed at both ends.

As to claim 11, Tinnerman illustrates that the cushioning projection is capable of having a thickness of between about .020 and about .090 inches.

Therefore, it would have being obvious to one having ordinary skill in the art at the time the invention was made to provide the cushioning projection described by Tinnerman with a thickness of between about .020 and about .090 inches since the change in the dimension of a prior art device is a design consideration within the skill of the art. Furthermore, the current specification fails to shows or demonstrates any showing of criticality having this dimension as the thickness of the cushioning portion.

11. Claims 1,4,6-8,10,11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 2,858,583 to McEvoy et al (McEvoy) in view of US Pat No 1,998,791 to Schanz.

Regarding claims 1 and 13, McEvoy discloses a device comprising a base member (27 and 28) having opposite first and second faces and a cushioning projection (25) extending outwardly from the second face of the base member and

covering and defining a void within the base member. The base member has a planar portion extending away from the cushioning projection on opposite sides of the projection. The device is formed as a unitary member and entirely form of a polymeric material.

However, McEvoy fails to disclose that the device further comprises a clip connected to the base member. McEvoy discloses that the base member is attached by other means.

Schanz teaches that it is well known in the art to have a base member having a cushioning projection (14) and a clip (15) to attach the device to a surface. The device is formed as a unitary member and entirely formed of a polymeric material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device described by McEvoy with a clip, as taught by Schanz, in order to attach the device to a surface with a simple and easy to install structure.

As to claim 4, McEvoy illustrates that the projection has a convex portion extending outwardly from the second face of the base member and the base member has a planar portion opposite the convex portion across from the void.

As to claim 6, McEvoy illustrates that the convex portion of the projection has a thickness that is less than the thickness of the base member.

As to claim 7, McEvoy illustrates that the cushioning projection is elongated in a direction generally perpendicular to the thickness of the base member.

As to claim 8, McEvoy illustrates that the cushioning projection is generally semi-circular.

As to claim 10, McEvoy illustrates that the cushioning projection is closed at both ends.

As to claim 11, McEvoy illustrates that the cushioning projection is capable of having a thickness of between about .020 and about .090 inches.

Therefore, it would have being obvious to one having ordinary skill in the art at the time the invention was made to provide the cushioning projection described by McEvoy with a thickness of between about .020 and about .090 inches since the change in the dimension of a prior art device is a design consideration within the skill of the art. Furthermore, the current specification fails to shows or demonstrates any showing of criticality having this dimension as the thickness of the cushioning portion.

12. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 3,952,455 to McAlarney (McAlarney '455).

McAlarney '455 fails to positively disclose that the cushioning projection has a thickness of between about .020 and about .090 inches. McAlarney '455 illustrates that the cushioning projection is capable of having a thickness of between about .020 and about .090 inches.

Therefore, it would have being obvious to one having ordinary skill in the art at the time the invention was made to provide the cushioning projection described by McAlarney '455 with a thickness of between about .020 and about .090 inches since the change in the dimension of a prior art device is a design consideration within the

skill of the art. Furthermore, the current specification fails to shows or demonstrates any showing of criticality having this dimension as the thickness of the cushioning portion.

13. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 6,148,584 to Wilson.

Wilson fails to positively disclose that the cushioning projection has a thickness of between about .020 and about .090 inches. Wilson illustrates that the cushioning projection is capable of having a thickness of between about .020 and about .090 inches.

Therefore, it would have being obvious to one having ordinary skill in the art at the time the invention was made to provide the cushioning projection described by Wilson with a thickness of between about .020 and about .090 inches since the change in the dimension of a prior art device is a design consideration within the skill of the art. Furthermore, the current specification fails to shows or demonstrates any showing of criticality having this dimension as the thickness of the cushioning portion.

14. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 2,185,161 to Tinnerman in view of US Pat No 1,998,791 to Schanz and further in view of US Pat No 6,148,584 to Wilson.

Tinnerman discloses a device (C) comprising a base member having opposite first and second faces and a cushioning projection (Figures 1 and 2) extending outwardly from the second face of the base member and covering and defining a void

within the base member. The device is formed as a unitary member and entirely form of a polymeric material.

However, Tinnerman fails to disclose that the device further comprises a clip connected to the base member. Tinnerman discloses that the base member is attached by other means.

Schanz teaches that it is well known in the art to have a base member having a cushioning projection (14) and a clip (15) to attach the device to a surface. The device is formed as a unitary member and entirely formed of a polymeric material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device described by Tinnerman with a clip, as taught by Schanz, in order to attach the device to a surface with a simple and easy to install structure.

Further, Tinnerman fails to disclose that the base member has a planar portion extending away from the cushioning projection on opposite sides of the projection. Tinnerman only discloses that the base member has a planar portion extending away from the cushioning projection on one side of the protrusion.

Wilson teaches that it is well known in the art to have a planar portion extending away from the cushioning projection on opposite sides of the projection (Figure 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the cushioning portion described by Tinnerman with two planar portions at opposing sides of the projection, as taught by Wilson, since, first, the duplication of components of a prior art device is a design consideration

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within the skill of the art, and second, in order to provide support for the cushioning portion. Furthermore, the current specification fails to show or demonstrate any showing of criticality having these planar portions at opposite sides of the projection.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 571-272-7058. The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-272-7049.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

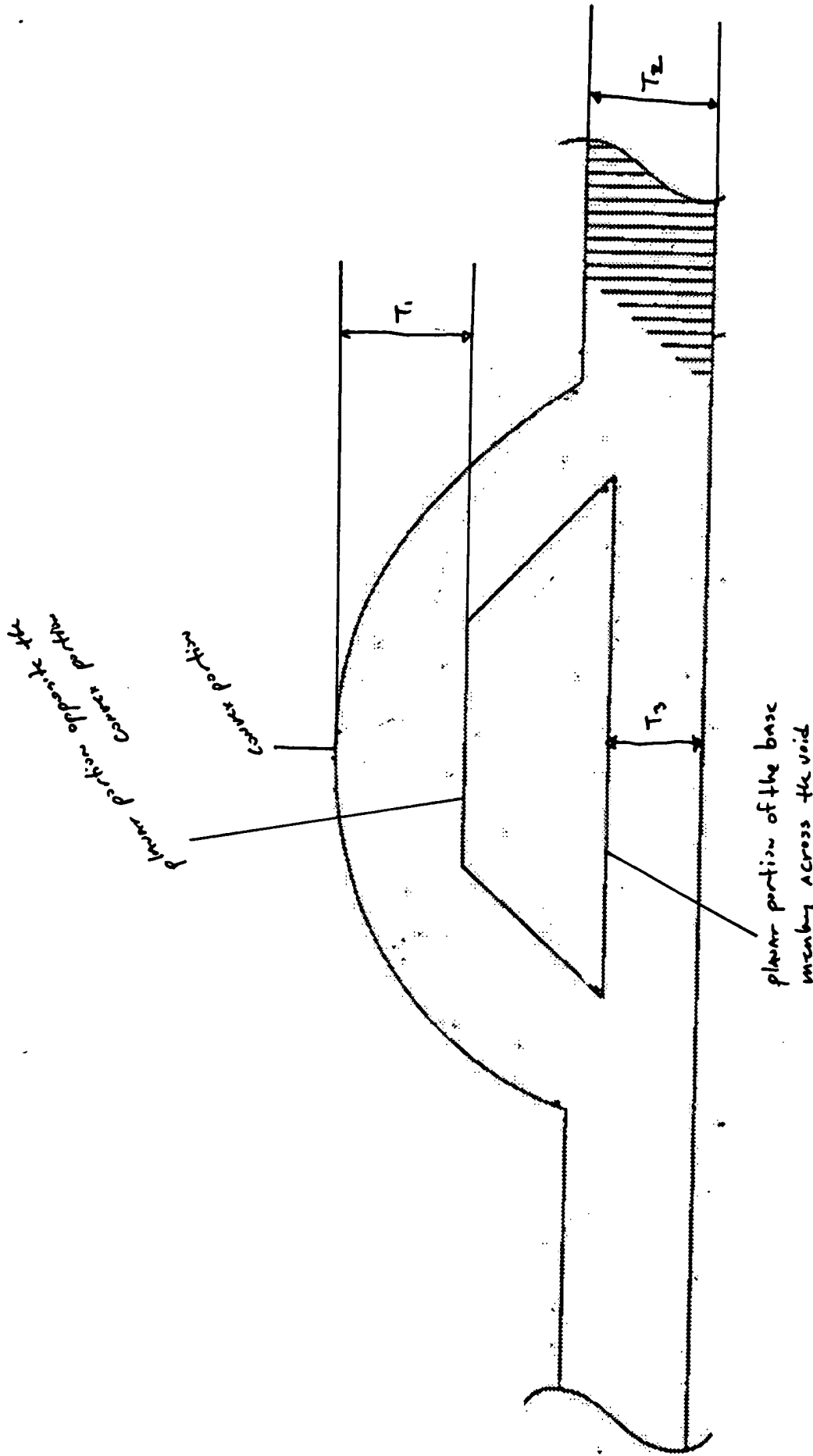
C.L.

Carlos Lugo
AU 3676

November 23, 2005.



**BRIAN E. GLESSNER
SUPERVISORY PATENT EXAMINER**



T_1 = Thickness of the portion between the plasma and the covers portion of the projection

T_2 = thickness of the base membrane

T_3 = thickness of the plasma portion of the base membrane across the void

$$T_1 \approx T_2$$

$$T_1 > T_3$$

$$T_2 > T_3$$

